

### **REMARKS/ARGUMENTS**

This present Response is being filed in reply to the Office Action dated February 23, 2006. Applicant requests a three month extension of time, including the associated fee, extending the period of response to and including August 23, 2006. Please charge any fees which may be due to Deposit Account No. 10-0750/DEP5033USNP/DAL, but do not include any payment of issue fees.

By the present amendment, claims 7, 8, 11, 14, 19, and 20 have been amended. Claims 6 and 21 are withdrawn from consideration. Claims 1-5 and 7-20 are pending in the application. Support for the claim amendments can be found throughout the specification and drawings, including the claims as originally filed. No new matter has been added. The amendment of the claims should in no way be construed to be an acquiescence to any of the rejections. The amendment of the claims is being made solely to expedite prosecution of the above-identified patent application. Applicants reserve the option to further prosecute the same or similar claims in the present or subsequent patent applications.

#### ***Allowable Subject Matter***

The Applicant wish to thank the Examiner for indicating that claims 3, 4, 8-10 and 15-17 recite allowable subject matter.

#### ***Objection to the Drawings***

The Office Action objects to the drawings for various informalities including illegible reference numerals and extraneous matter. Applicant submits formal drawings herewith to address these informalities. In addition, Applicant amends FIG. 4, to change reference numeral 60 to 61a and to add reference numerals 61b, 62a, 66b and 68b. Applicant amends paragraphs 30 and 31 of the Application to correspond to the reference numerals on FIG. 4.

#### ***Objections to the Claims***

The Office Action objects to claims 1-5 and 7-20 for various informalities.

The Office Action objects to claim 1 for an inconsistency between the language of preamble and the language of the body of the claim and requires the Applicant to indicate the subject matter to which the claim is directed and the amend the claim such that the language is consistent with this intent. The Applicant traverses this rejection.

The Office Action provides neither statutory basis nor any patent rule as a basis for the objection to claim 1. Applicant considers claim 1 to meet all of the requirements of 35 U.S.C. § 112, paragraph 2. Applicant notes MPEP 2173.01, reproduced below:

***2173.01 Claim Terminology***

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

In the absence of a specific rejection to claim 1 or a particular noted informality, such as a spelling or typographical error, Applicant declines the instruction to amend claim 1 and requests withdrawal of the objection to claim 1.

Claims 7, 8, 11, 14, 16, 19, and 20 have been amended as suggested by the Office Action. Applicant does not consider any of these amendments to be narrowing amendments.

***Rejection of Claims 1, 2, 5, 7, 11, 19 and 20 under 35 U.S.C. § 102***

The Office Action rejected claims 1, 2, 5, 7, 11, 19 and 20 under 35 U.S.C. § 102(b) as being anticipated by Bryant (U.S. Patent No. 5,649,931). Applicant respectfully traverses this rejection on the basis of the following arguments.

Independent claims 1, 7, and 11 are directed to a tool comprising an inserter shaft having a distal end adapted to hold a closure mechanism for a spinal implant. Such an arrangement permits placement of the closure mechanism after seating of the rod without

removal of the tool from the spinal implant. Bryant fails to disclose an inserter shaft having a distal end adapted to hold a closure mechanism for a spinal implant, as recited in claims 1, 7, and 11. Instead, Bryant discloses an orthopedic apparatus 10 having a shaft 16 having a distal end 34 having an exterior configuration “which is adapted to mate with recess 24 of the enlarged head 22. More particularly, distal end 34 has a hexagonal exterior configuration which is adapted to be received within recess 24 and thereby engage bone screw 12.” Col. 3, lines 5-15, of Bryant.

For at least this reason, Applicant request withdrawal of the rejection of claims 1, 7, and 11, and claims 2, 5, 19, and 20 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Bryant.

***Rejection of Claims 11-13 and 18 under 35 U.S.C. § 102***

The Office Action rejected claims 11-13 and 18 under 35 U.S.C. § 102(b) as being anticipated by Becker (U.S. Patent No. 2,248,054). Applicant respectfully traverses this rejection based on the following arguments.

Claim 11 is directed to a tool comprising an inserter shaft having a distal end adapted to hold a closure mechanism for a spinal implant. Such an arrangement permits placement of the closure mechanism after seating of the rod with out removal of the tool from the spinal implant. Becker fails to disclose an inserter shaft having a distal end adapted to hold a closure mechanism for a spinal implant, as recited in claim 11. Instead, Becker discloses a screwdriver having a driver 19 having a blade 20 adapted to engage a slot 25 in the head of a screw 24. Col. 2, lines 21-23 and 38-51, of Becker.

For at least this reason, Applicant request withdrawal of the rejection of claim 11, and claims 12, 13 and 18 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Becker.

***Rejection of Claims 11-14 under 35 U.S.C. § 102***

The Office Action rejected claims 11-14 under 35 U.S.C. § 102(b) as being anticipated by Torode (U.S. Patent Publication Number: 2003/0004519 ). Applicant traverses this rejection based on the following arguments.

Claim 11 is directed to a tool comprising a body having a distal end portion having branches for gripping a spinal implant and an interior channel extends between the distal and proximal ends. Claim 11 further recites that the tool comprises an inserter shaft sized to fit within the interior channel of the body. Torode fails to disclose a tool comprising a body having a distal end portion having branches for gripping a spinal implant and an inserter shaft sized to fit within an interior channel of the body, as recited in claim 1. Instead, Torode discloses a holder 700 including an inner cylindrical guide member 710, which includes a jaw assembly 730 at its distal end, that rotatably fits within an outer guide member 720. Thus, Torode lacks a body having (1) a distal end portion having branches for gripping a spinal implant and (2) an interior guide channel receiving an inserter shaft.

For at least this reason, Applicant request withdrawal of the rejection of claim 11, and claims 12-14 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Torode.

### **Conclusion**

In view of the remarks set forth above, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If there are any remaining issues or the Examiner believes that a telephone conversation with the Applicants' attorney would be helpful in expediting the prosecution of the application, the Examiner is invited to call the undersigned at (508) 880-8488.

Respectfully submitted,

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